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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/726,808 | 12/02/2003 | Luis Elenes | 200309860-1 | 4114 |

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EXAMINER

KOHNER, MATTHEW J

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,808

Applicant(s)

ELENES, LUIS

Examiner

Matthew J. Kohner

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 17, 18, 20 and 27 is/are rejected.
- 7) ☒ Claim(s) 13-16, 19 and 21-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/2/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant has argued that the claims define over the prior art since US Patent No. 4,681,312 to Harvey does not disclose the limitation of “configured to engage the trailing edge of a sheet medium and lift the trailing edge upward and over the rotatable member.” Further, Applicant argues in Harvey the sheets are ejected from the nip rollers and therefore can not be lifted by the nip rollers. Examiner respectfully disagrees. Merely because the rollers eject the sheet does not mean they do not lift the sheet. “Lift” is defined merely as to raise from a lower to a higher position” (Merriam Webster’s collegiate dictionary, 10th edition). Further, the trailing edge of the sheet is broad language and can be reasonably interpreted to be simply the bottom quarter of the sheet. Under this interpretation, the nip rollers do engage the trailing edge of the sheet.

Applicant has also argued that Harvey does not disclose carrying a trailing edge of the sheet medium upward and then over a roller. Examiner again respectfully disagrees. First, the term “carry” does not necessarily mean the item must be supported. For example, carry can be defined as “to contain and direct the course of” (Merriam Webster’s collegiate dictionary, 10th edition). Therefore, the nip rollers do carry the trailing edge of the sheet medium in an upward direction. Further, it is that carrying that allows the sheet to go over the roller to the bin.

Therefore, the rejections of claim 1, 3-10 and 27 are maintained.

The rejections of claims 2, 12-23, 25 and 26 are withdrawn since Harvey does not disclose a resilient member connected to the rotatable member nor a resilient member deflected in a direction opposite the direction of rotation.

Further, as a result of a new grounds of rejection, this action is non-final.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one resilient member extending from the rotatable member in a direction generally opposite to the direction the rotatable member is configured to rotate must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Examiner submits the projections (96) extend from the roller in a radial direction, which is not a direction generally opposite to the direction of rotation.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation the at least one resilient member extending from the rotatable member in a direction generally opposite to the direction the rotatable member is configured to rotate. This language of “generally opposite” is vague and unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 11, 17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,981,496 to Jensen et al.

Jensen discloses a method of processing sheet media comprising:

- moving a sheet medium (7) upward by contact of a face of the sheet medium with

Art Unit: 3653

a roller (1); and

- carrying a trailing edge of the sheet medium upward and then over the roller (see Fig. 4).

In regard to claim 2, Jensen discloses the elements 8 are soft and compressible.

Therefore, examiner submits that the elements will deflect (even if only slightly) in a direction opposite to the first direction.

In regard to claims 3, 4 and 5, see Fig. 4.

In regard to claim 11, Jensen discloses a media processing apparatus, comprising:

- a rotatable member (1) and
- a resilient member (8) connected to the rotatable member and configured to engage a trailing edge of a sheet medium and lift the trailing edge upward and over the rotatable member as the rotatable member rotates.

In regard to claims 17 and 20, see Fig. 4.

Claims 1, 3-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,681,312 to Harvey.

Harvey discloses a method of processing sheet media comprising:

- moving a sheet medium (1) upward by contact of a face of the sheet medium with a roller (4b); and
- carrying a trailing edge of the sheet medium upward and then over the roller (see Fig. 1).

In regard to claim 3-5, see Fig. 1.

In regard to claims 6 and 7 and 27, Harvey discloses a photocopier, see abstract.

In regard to claim 8-10, see Fig. 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-10, 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen.

In regard to claims 6, 7, 18 and 27, Jensen does not disclose adding colorant. However, Examiner submits it would be obvious to one of ordinary skill in the art that one could use Jensen's method in discharging printed sheets (which contain ink [i.e. a colorant]) instead of film sheets. Further, Jensen transmits the sheets along an arcuate path (see Fig. 4).

In regard to claims 8-10, see Fig. 4.

Allowable Subject Matter

Claims 13-16, 19, 21-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

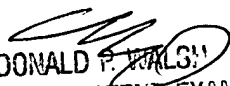
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kohner whose telephone number is 571-272-6939. The examiner can normally be reached on Mon-Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 571-272-6944. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew J. Kohner
Examiner
Art Unit 3653

mjk


DONALD P. WALSH
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